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EXAMINER

JOHANNSEN, D

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| ART UNIT | PAPER NUMBER |
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13

1655  
DATE MAILED:

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks



***ELECTION/RESTRICTION***

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-11, drawn to use of primer or primer pair "for DNA fingerprint analysis".

Group II, claim(s) 12-13, drawn to primers and kits comprising primers.

Group III, claim(s) 14, drawn to use of a primer in preparation of a kit.

Group IV, claim(s) 15, drawn to use of a primer in detection of "recombination events in cross breeding".

2. The inventions listed as Groups I-IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons.

The inventions of Groups I-IV do share a technical feature with one another, in that the method of Group I encompasses the use of primers as set forth in, e.g., Table 2, which primers are also encompassed by the compositions of Group II, the kit preparation methods of Group III, and the methods for detecting recombination events of Group IV. However, primers encompassed by the compositions and kits of Group II and of the type employed in the fingerprinting method of Group I, the kit preparation

method of Group III, and the detection of recombination events of Group IV are known in the art. For example, Rohde (J. Genet. Breed. 50:249-261 [9/1996]) discloses several of the primers recited in Tables 1 and 2 and disclose the use of these primers in fingerprinting. Accordingly, while the inventions of Groups I-IV do share a technical feature, that technical feature does not constitute a special technical feature as defined by PCT Rule 13.2. *The term "special technical features" is defined as meaning those technical features that define a contribution which each of the inventions considered as a whole, makes over the prior art.* See MPEP 1850. As the primers of the present claims do not constitute a contribution over the prior art, they do not constitute a special technical feature shared by Inventions I-IV. Further, it is noted that the methods of Inventions I, III, and IV do not share any other characteristics that could constitute a shared special technical feature. The methods are distinct from each other as they require the practice of different process steps to achieve distinct objectives. Specifically, the invention of Group I requires steps such as amplification to achieve the objective of fingerprinting. While no method steps are recited in claim 14, a method of preparing a kit using primers would require steps of, e.g., packaging reagents, to achieve the objective of kit preparation. While no method steps are recited in claim 15, a method for detecting recombination events "in cross breedings" would require steps of, e.g., cross breeding plants, to achieve the objective of detecting recombination events.

Therefore, the claims are not linked by a special technical feature within the meaning of PCT Rule 13.2 so as to form a single general inventive concept.

3. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diana B. Johannsen whose telephone number is 703/305-0761. The examiner can normally be reached on Monday-Friday, 7:00 am-3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones can be reached on 703/308-1152. The fax phone numbers for the organization where this application or proceeding is assigned are 703/305-3014 for regular communications and 703/305-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703/308-0196.

Diana B. Johannsen  
September 10, 2001

  
W. Gary Jones  
Supervisory Patent Examiner  
Technology Center 1600